United States District Court

For the Northern District of California

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

MASTEROBJECTS, INC.,

      Plaintiff,   No. C 11-02539 JSW

    v.

YAHOO!, INC.,   **CLAIM CONSTRUCTION ORDER**

      Defendant.

                                    /

     The Court has been presented with a technology tutorial and briefing leading up to a hearing pursuant to *Markman v. Westview Instruments, Inc.,* 517 U.S. 370 (1996). This Order construes the disputed claim terms selected by the parties, which appear in the three patents at issue in this case: United States Patent No. 7,752,326 ("the '326 Patent") called "System and Method for Utilizing Asynchronous Client Server Communication Objects," a continuation of the '326 Patent, United States Patent No. 8,060,639 ("the '639 Patent") called "System and Method for Utilizing Asynchronous Client Server Communication Objects," and United States Patent No. 8,112,529 ("the '529 Patent") called "System and Method for Asynchronous Client Server Session Communication."

BACKGROUND

     MasterObjects, Inc. ("MasterObjects") contends that defendant Yahoo!, Inc. ("Yahoo!") infringes three of its patents. MasterObjects' patents provide a method for sending a character-by-character string of data to a server, which analyzes the lengthening string of characters and returns to the client increasingly appropriate information.

1   The Court shall address additional facts as necessary in the remainder of this Order.

2   **ANALYSIS**

3   **A.   Legal Standard.**

4   "It is a bedrock principle of patent law that the claims of a patent define the invention to

5   which the patentee is entitled the right to exclude." *Innova/Pure Water*, *Inc*. *v*. *Safari Water*

6   *Filtration Sys*., *Inc*., 381 F.3d 1111, 1115 (Fed. Cir. 2004). The interpretation of the scope and

7   meaning of disputed terms in patent claims is a question of law and exclusively within the

8   province of a court to decide. *Markman*, 517 U.S. at 372. The inquiry into the meaning of the

9   claim terms is "an objective one." *Innova/Pure Water*, 381 F.3d at 1116. As a result, when a

10   court construes disputed terms, it "looks to those sources available to the public that show what

11   a person of skill in the art would have understood the disputed claim language to mean." *Id*. In

12   most cases, a court's analysis will focus on three sources: the claims, the specification, and the

13   prosecution history. *Markman v. Westview Instruments*, *Inc*., 52 F.3d 967, 979 (Fed. Cir. 1995)

14   (en banc), *aff'd*, 517 U.S. 370 (1996). However, on occasion, it is appropriate to rely on

15   extrinsic evidence regarding the relevant scientific principles, the meaning of technical terms,

16   and the state of the art at the time at the time the patent issued. *Id.* at 979-981.

17   The starting point of the claim construction analysis is an examination of the specific

18   claim language. A court's "claim construction analysis must begin and remain centered on the

19   claim language itself, for that is the language that the patentee has chosen to particularly point

20   out and distinctly claim the subject matter which the patentee regards as his invention."

21   *Innova/Pure Water*, 381 F.3d at 1116 (internal quotations and citations omitted). Indeed, in the

22   absence of an express intent to impart a novel meaning to a term, an inventor's chosen language

23   is given its ordinary meaning. *York Prods*., *Inc. v. Cent. Tractor Farm & Family Center*, 99

24   F.3d 1568, 1572 (Fed. Cir. 1996). Thus, "[c]laim language generally carries the ordinary

25   meaning of the words in their normal usage in the field of the invention." *Invitrogen Corp. v.*

26   *Biocrest Mfg*., *L.P*., 327 F.3d 1364, 1367 (Fed. Cir. 2003); *see also Renishaw v. Marposs*

27   *Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (recognizing that "the claims define

28   the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in

1   all cases with the actual words of the claim"). A court's final construction, therefore, must

2   accord with the words chosen by the patentee to mete out the boundaries of the claimed

3   invention.

4   The court should also look to intrinsic evidence, including the written description, the

5   drawings, and the prosecution history, if included in the record, to provide context and

6   clarification regarding the intended meaning of the claim terms. *Teleflex*, *Inc. v. Ficosa N. Am.*

7   *Corp.*, 299 F.3d 1313, 1324-25 (Fed. Cir. 2002). The claims do not stand alone. Rather, "they

8   are part of 'a fully integrated written instrument.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315

9   (Fed. Cir. 2005) (en banc) (quoting *Markman*, 52 F.3d at 978). The specification "may act as a

10 sort of dictionary, which explains the invention and may define terms used in the claims."

11 *Markman*, 52 F.3d at 979. The specification also can indicate whether the patentee intended to

12 limit the scope of a claim, despite the use of seemingly broad claim language. *SciMed Life Sys.*,

13 *Inc. v. Advanced Cardiovascular Sys.*, *Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (recognizing

14 that when the specification "makes clear that the invention does not include a particular feature,

15 that feature is deemed to be outside the reach of the claims of the patent, even though the

16 language of the claims, read without reference to the specification, might be considered broad

17 enough to encompass the feature in question").

18   Intent to limit the claims can be demonstrated in a number of ways. For example, if the

19 patentee "acted as his own lexicographer," and clearly and precisely "set forth a definition of

20 the disputed claim term in either the specification or prosecution history," a court will defer to

21 that definition. *CCS Fitness*, *Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). In

22 order to so limit the claims, "the patent applicant [must] set out the different meaning in the

23 specification in a manner sufficient to give one of ordinary skill in the art notice of the change

24 from ordinary meaning." *Innova/Pure Water*, 381 F.3d at 1117. In addition, a court will adopt

25 an alternative meaning of a term "if the intrinsic evidence shows that the patentee distinguished

26 that term from prior art on the basis of a particular embodiment, expressly disclaimed subject

27 matter, or described a particular embodiment as important to the invention." *CCS Fitness*, 288

28 F.3d at 1367. For example, the presumption of ordinary meaning will give way where the

United States District Court

For the Northern District of California

1   "inventor has disavowed or disclaimed scope of coverage, by using words or expressions of

2   manifest exclusion or restriction, representing clear disavowal of claim scope." *Gemstar-TV*

3   *Guide Int'l Inc. v. ITC*, 383 F.3d 1352, 1364 (Fed. Cir. 2004). The disclaimer in the prosecution

4   history must be "clear and unmistakable." *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314,

5   1325-26 (Fed. Cir. 2003). Likewise, the specification may be used to resolve ambiguity "where

6   the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to

7   permit the scope of the claim to be ascertained from the words alone." *Teleflex*, 299 F.3d at

8   1325.

9   However, limitations from the specification (such as from the preferred embodiment)

10   may not be read into the claims, absent the inventor's express intention to the contrary. *Id*. at

11   1326; *see also CCS Fitness*, 288 F.3d at 1366 ("[A] patentee need not 'describe in the

12   specification every conceivable and possible future embodiment of his invention.'") (quoting

13   *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001)). To protect against this

14   result, a court's focus should remain on understanding how a person of ordinary skill in the art

15   would understand the claim terms. *Phillips*, 415 F.3d at 1323. Additionally, "[w]hen

16   consulting the specification to clarify the meaning of claim terms, court must take care not to

17   import limitations into the claims from the specification." *Abbott Laboratories v. Sandoz, Inc.*,

18   566 F. 3d 1282, 1288 (Fed. Cir. 2009).

19   Similarly, the Federal Circuit has repeatedly cautioned courts against reading limitations

20   into the claims based on a preferred embodiment: "although the specification often describes

21   very specific embodiments of the invention, we have repeatedly warned against confining the

22   claims to these embodiments." *Phillips*, 415 F. 3d at 1323. Courts have also "expressly

23   rejected the contention that if a patent describes only a single embodiment, the claims of the

24   patent must be construed as being limited to that embodiment." *Liebel-Flarsheim Co. v.*

25   *Medrard, Inc.*, 358 F. 3d 898, 906 (Fed. Cir. 2004).

26   If the analysis of the intrinsic evidence fails to resolve any ambiguity in the claim

27   language, a court then may turn to extrinsic evidence, such as expert declarations and testimony

28   from the inventors. *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003)

United States District Court
For the Northern District of California

1 ("When an analysis of *intrinsic* evidence resolves any ambiguity in a disputed claim term, it is

2 improper to rely on extrinsic evidence to contradict the meaning so ascertained.") (emphasis in

3 original). When considering extrinsic evidence, a court should take care not to use it to vary or

4 contradict the claim terms. Rather, extrinsic evidence is relied upon more appropriately to

5 assist in determining the meaning or scope of technical terms in the claims. *Vitronics Corp. v.*

6 *Conceptronic*, *Inc.*, 90 F.3d 1576, 1583-84 (Fed. Cir. 1996).

7   Dictionaries also may play a role in the determination of the ordinary and customary

8 meaning of a claim term. In *Phillips*, the Federal Circuit reiterated that "[d]ictionaries or

9 comparable sources are often useful to assist in understanding the commonly understood

10 meanings of words . . . ." *Phillips*, 415 F.3d at 1322. The *Phillips* court, however, also

11 admonished that district courts should be careful not to allow dictionary definitions to supplant

12 the inventor's understanding of the claimed subject matter. "The main problem with elevating

13 the dictionary to . . . prominence is that it focuses the inquiry on the abstract meaning of the

14 words rather than on the meaning of claim terms within in the context of the patent." *Id*. at

15 1321. Accordingly, dictionaries necessarily must play a role subordinate to the intrinsic

16 evidence.

17   In addition, a court has the discretion to rely upon prior art, whether or not cited in the

18 specification or the file history, but only when the meaning of the disputed terms cannot be

19 ascertained from a careful reading of the public record. *Vitronics*, 90 F.3d at 1584. Referring to

20 prior art may make it unnecessary to rely upon expert testimony, because prior art may be

21 indicative of what those skilled in the art generally understood certain terms to mean. *Id.*

22 **B.   Claim Construction.**

23   **1.   "Asynchronous connection"**

24   The term "asynchronous connection" appears in Claims 1 and 18 of the '326 Patent,

25 Claims 1 and 13 of the '639 Patent, and Claim 1 of the '529 Patent.

26   MasterObjects argues that the term "asynchronous connection" must be construed to

27 mean "A connection that allows one side of the communication to communicate at the same

28 time the other side is also communicating within a session." (Parties' Joint Claim Construction

5

1   and Pre-hearing Statement ("Statement") at 2.) Yahoo!, on the other hand, argued at the

2   *Markman* hearing that "asynchronous connection" should be construed to mean "a connection

3   that allows either side of the communication to initiate communications at any moment in time

4   within a session."

5   Both parties agreed at the *Markman* hearing the term should be construed to include

6   language that allows for the client and server to communicate with each other at the same time

7   and both parties agreed that the language "within a session" should be included the claim's

8   construction. However, the parties dispute whether the asynchronous connection must allow

9   the server as well as the user to "initiate" a communication within a session. Under Yahoo!'s

10   proposed construction, an "asynchronous connection" would allow the server to send requests

11   to the client without any initial request from the client.

12   Claim 1 of the '529 Patent describes a system comprising "a communication protocol

13   that enables an asynchronous connection" between a client and server, that "allows the client

14   system to send . . . within a session . . . a lengthening string . . . of consecutively input

15   characters . . . to the server . . . while asynchronously receiving consecutive responses form the

16   server system as the characters are being input." ('529 Patent at 31:38-58.) In Claim 1 of the

17   '529 Patent, the client initiates and the server receives.

18   Yahoo! argues that the specification teaches that the server must also be able to initiate

19   communication within a session. Yahoo! cites to a paragraph in the specification that states:

20   "The system is bi-directional and asynchronous, in that both the Client and the Server can

21   initiate communications at any moment in time." (*Id*. at 12:23-24.) Yahoo! also relies on

22   another sentence located within the same paragraph which states: "An example of a

23   communication initiated by the Server is updating the information provided to the Client." (*Id*.

24   at 12:30-33.) MasterObjects responds that the specification language cited by Yahoo! only

25   describes a preferred embodiment of the invention. *See Philips*, 415 F.3d at 1323 ("although

26   the specification often describes specific embodiments of the invention, we have repeatedly

27   warned against confining the claims to those embodiments"); *see also Teleflex*, 299 F.3d at

28   1326 ("Limitations from the specification (such as from the preferred embodiment) may not be

1   read into the claims, absent the inventor's express intention to the contrary."); *see also CCS*

2   *Fitness*, 288 F.3d at 1366.

3   The Court agrees that Yahoo!'s analysis attempts to read limitations into the claim based

4   on a preferred embodiment. The paragraph that Yahoo! relies on clearly refers to the

5   QuestObjects embodiment. The section describing the embodiment provides:

6   In the detailed description below, an embodiment of the present invention is
             referred to as QuestObjects, and provides a system of managing client input,
7   server queries, server responses and client output. One specific type of data
             made available through the system from a singe source (or syndicate of sources)
8   is referred to as a QuestObjects Service.

9   ('529 Patent at 9:49-54; *see also id.* at 9:6-8 ("In the detailed description below, the present

10   invention is described with reference to a particular embodiment named QuestObjects"); *see*

11   *also id.* at 31:33-36 ("The foregoing description of preferred embodiments of the present

12   invention has been provided for the purpose of illustration and description. It is not intended to

13   be exhaustive or to limit the invention to the precise forms disclosed.").) Accordingly, the

14   Court finds the language cited by Yahoo! only to refer to a limitation of a specific embodiment,

15   the QuestObjects system.

16   Yahoo! also argues that MasterObjects limited the construction of the term through

17   MasterObjects' prosecution history. A party may limit the meaning of their claim language

18   when "the patentee has unequivocally disavowed a certain meaning to obtain his patent, the

19   doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim

20   congruent with the scope of the surrender." *Omega Eng'g*, 334 F.3d at 1324. Yahoo! cites to a

21   single sentence in MasterObject's prosecution history, located in the middle of a paragraph

22   which states: "Furthermore, since the system is *asynchronous*, both the client and the server can

23   initiate communications at any moment in time." (Declaration of Kevin Smith ("Smith Decl."),

24   Ex. D at 12.) In the preceding paragraph that Yahoo! cites to, the patentee discusses its

25   amendment to the system claim. The paragraph states:

26   As defined by Claim 1, as currently amended, the system comprises a
             communication protocol that provides an asynchronous session-based connection
27   between a client and server. As part of a session, *the client sends a plurality of*
             consecutively input strings to query the server for content . . . . A server object
28   records, during the same session, each of the plurality of queries. As the search
             string is being lengthened or shortened, the server object automatically matches

7

1   the focused query string against the content of the server system, *and returns*
       increasingly relevant content information to the client for immediate use by the
2   client system.

3   (*Id.* at 11-12) (emphasis added). Further, the beginning of the paragraph to which Yahoo! cites

4   provides: "The advantages of such a session-based protocol included that the server *recognizes*

5   when subsequent requests originate at the same client. Thus, in *responding* to an input

6   character the server *receives* from the client . . . ." (*Id.*) (emphasis added).

7   Here, in the cited prosecution history, MasterObjects explains the advantages of a

8   session-based asynchronous connection. MasterObjects does not argue that their invention is

9   distinguishable because the server can initiate a communication with the client. Rather,

10   MasterObjects makes clear that an asynchronous connection *can* have a server initiate

11   communications.   In its amendment, MaseterObjects states that as part of a session, the client

12   first sends input to the server, and then the server returns increasingly relevant information.

13   MasterObjects, in the following paragraph, states that the advantage of the session-based

14   protocol is that the server *recognizes* when requests *originate* at the client. The language cited

15   by Yahoo! describes how the asynchronous connection works *within a session*, that is, the client

16   and server can communicate with one another whenever they please.

17   Accordingly, the Court does not find MasterObjects has unequivocally disavowed their

18   construction of "asynchronous connection" in the prosecution history. The Court construes the

19   term "asynchronous connection" to mean: "A connection the allows one side of the

20   communication to communicate at the same time the other side is also communicating within a

21   session."

22   **2.   "Communication protocol"**

23   The term "communication protocol" appears in Claims 1 and 18 of the '326 Patent,

24   Claims 1 and 13 of the '639 Patent, and Claims 1, 44, and 45 of the '529 Patent.

25   MasterObjects argues that the term "communication protocol" should be construed to

26   mean "A set of rules that enable computers to exchange messages with each other." (Statement

27   at 2.) Yahoo!, on the other hand, argues that the term must be construed to mean "A set of rules

28   or standards designed to enable computers to connect with one another and to exchange

1   information and that is optimized for sending single characters from a client to a server and lists

2   of strings from the server to the client." (*Id.*)

3   The key dispute between the parties is whether the protocol must be "optimized for

4   sending single characters from a Client to a Server and lists of strings from the server to the

5   client."

6   Yahoo!'s argues that when MasterObjects uses the language "*the invention includes . . .*

7   *a communication protocol . . . optimized for sending characters*," the construction of the term

8   "communication protocol" must be optimized for sending single characters. The language

9   Yahoo! relies on in support of its proposed construction states: "The invention includes a

10   Server that handles requests for information from clients, and a communication protocol that is

11   optimized for sending characters from a Client to the Server, and lists of strings from the Server

12   to the Client." ('639 Patent at 13:58-62; '529 Patent at 11:55-59.)

13   The Court agrees with Yahoo! that a disclosure that begins with "the invention" should

14   be given more weight. *See Trading Techs. Int'l v. eSpeed, Inc.*, 595 F.3d 1340, 1353 (Fed. Cir.

15   2010) (a "reference to 'the present invention' strongly suggests" that the patentee is not

16   describing a mere embodiment); *see also Honeywell Int'l, Inc. v. ITT Indus., Inc.*, 452 F.3d

17   1312, 1318 (Fed. Cir. 2006) (finding the terms "this invention" and "the present invention" to

18   limit the claims). However, the Court finds Yahoo! again attempts to read limitations into the

19   claims based on the QuestObjects preferred embodiment.

20   As the Court has previously discussed with respect to the term "asynchronous

21   connection," MasterObjects has explained that the "detailed description" is "an embodiment of

22   the present invention," that is, the QuestObjects preferred embodiment. (*See* '529 Patent at

23   9:49-56.) These "[l]imitations from the specification (such as from the preferred embodiment)

24   may not be read into the claims, absent the inventor's express intention to the contrary."

25   *Teleflex*, 299 F.3d at 1326 ; *see also CCS Fitness*, 288 F.3d at 1366.

26   Further, the single sentence Yahoo! relies on for its construction is embedded in the

27   middle of a long and detailed paragraph describing specific embodiments. Read in context, the

28   specification states the following: "The terms 'client' and 'server' are used herein to reflect a

1   *specific embodiment* of the invention . . . . The invention includes a Server . . . and a

2   communication protocol that is optimized for sending single characters from a Client to the

3   Server . . . ." ('529 Patent at 11:48-58 (emphasis added).) In the sentence which Yahoo! relies

4   upon for its construction, the terms server and client are capitalized indicating that the inventor

5   is describing one of the specific embodiments that was just mentioned in the proceeding

6   sentence rather than limiting the claimed invention.

7   Accordingly, the Court concludes that the specification does not clearly indicate an

8   intention to limit "communication protocol" to a protocol that is optimized for sending single

9   characters. The Court construes the term "communication protocol" to mean: "A set of rules

10   that enable computers to exchange messages with each other."

11   **3.   "Content-based cache/query and result cache"**

12   The terms "content-based cache and query and result cache" appear in Claims 1, 44, and

13   45 of the '529 Patent and Claims 1 and 13 of the '639 Patent.

14   MasterObjects argues that the term "content-based cache and query and result cache"

15   should be construed to mean "A cache which stores previous queries and content or other

16   information returned in response to previous queries." (Statement at 2.) Yahoo!, on the other

17   hand, argues that the term should be construed to mean "A persistent store of queries and

18   corresponding result sets executed by a content engine for a specific content channel, thus

19   improving performance on recurring queries and limiting the load imposed on content engines.

20   Memory that stores an index file that aids in retrieval of queries and result sets, but does not

21   store those queries and result sets, is not a cache." (*Id.*)

22   As an initial matter, the parties agree that the terms "content-based cache" and "query

23   and result cache" should be given the same construction. The key dispute between the parties is

24   whether Yahoo!'s proposed limitations should be included in the construction of the term.

25   The first issue is whether or not the glossary definition of "Content-based Cache" should

26   be used to provide guidance to define the term. Yahoo! argues the term requires including the

27   word "persistent" and that queries and results must be executed by a "content engine for a

28   specific content channel." In support of its argument, Yahoo! cites to the glossary in the '529

United States District Court
For the Northern District of California

1   Patent specification which states: "Content-based Cache - A persistent store of Queries and

2   corresponding Result Sets executed by a Content Engine for a specific Content Channel." ('529

3   Patent at 10:17-19.) However, courts have "expressly rejected the contention that if a patent

4   describes only a single embodiment, the claims of the patent must be construed as being limited

5   to that embodiment." *Liebel-Flarsheim*, 358 F.3d at 906; *see also MySpace, Inc. v. GraphOn*

6   *Corp.*, 672 F.3d 1250, 1255 (Fed. Cir. 2012) ("limitations from parts of the written description,

7   such as the details of the preferred embodiment, cannot be read into the claims absent a clear

8   intention by the patentee to do so.").

9   Here, the glossary refers to a preferred embodiment, the QuestObjects system. The

10 paragraph proceeding the Glossary states:

11   In the detailed description below, an *embodiment of the present invention* is
          referred to as QuestObjects, and provides a system of managing client input,
12   server queries, server responses and client output. One specific type of data
          made available through the system from a single course (or syndicate of sources)
13   is referred to as QuestObjects Service. *Other terms used to describe the*
          QuestObjects system in detail can be found in the glossary below.

14

15 ('529 Patent at 9:49-56 (emphasis added).) The patentee uses the glossary to describe one

16 particular embodiment, the QuestObjects system. Yahoo! seeks to import a specific limitation

17 from a glossary which is expressly limited to a preferred embodiment. This is not permitted.

18 *See Liebel-Flarsheim*, 358 F.3d at 906. Accordingly, the Court will not include the word

19 "persistent" or the limitation of the content engine in construing the term.

20   Next, Yahoo! argues that MasterObjects' prosecution history evidences that the patentee

21 has limited the scope of its claim and as a result the term should include the following

22 limitation: "Memory that stores an index file that aids in retrieval of queries and results sets, but

23 does not store those queries and results sets, is not a cache." A patentee may limit the meaning

24 of their claim language when "the patentee has unequivocally disavowed a certain meaning to

25 obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary

26 meaning of the claim congruent with the scope of the surrender." *Omega Eng'g*, 334 F. 3d at

27 1324.

28

11

1   Yahoo!'s argument is based on a rejection that MasterObjects received in light of the

2   prior art in the Curtis Patent. Curtis, the prior art reference, refers to a search engine which

3   utilizes a method and system for efficient storage and retrieval of data. (Smith Dec., Ex. J at

4   25.) The Curtis system is comprised of an index file, wherein the index file contains locations

5   of data items, pointers to other index files, or an empty designation. (*Id*.) MasterObjects

6   distinguished itself from this prior art reference by arguing that Curtis "does not store queries

7   and result sets." (*Id*.) Further, in distinguishing Curtis from Claim 1 of the '529 Patent,

8   MasterObjects contended that "Curtis only stores URLs and information related to the URL in

9   an index file. It is not clear to the Applicant whether Curtis shows a cache at all." (*Id*. at 30.)

10   Yahoo! argues that MasterObjects distinguished its invention by claiming that an index

11   file of URLs and information related to URLs is not a "cache" and therefore MasterObjects had

12   disclaimed coverage of such index files. However, MasterObjects did not make such an

13   argument before the Patent and Trademark Office. MasterObjects simply argued that "the

14   cache stores previous queries and corresponding result sets" which Curtis does not store. (*Id.* at

15   30.) Accordingly, the Court does not find that MasterObjects has disclaimed any coverage in

16   light of their response to the Curtis rejection.

17   Lastly, Yahoo! argues that the purpose of the cache is to "improve performance and

18   reduce load on the system." Yahoo! again cites to the glossary contained in the QuestObjects

19   embodiment. As stated above, courts have "expressly rejected the contention that if a patent

20   describes only a single embodiment, the claims of the patent must be construed as being limited

21   to that embodiment." *Liebel-Flarsheim*, 358 F.3d at 906.

22   The entire sentence of the language Yahoo! relies upon states: "The *QuestObjects*

23   Server caches query results in a cache that is common to all users, thus improving performance

24   on recurring queries and limiting the load imposed on content engines." ('639 Patent at 8:11-15

25   (emphasis added).) Here, the patentee explicitly refers to the QuestObjects preferred

26   embodiment. The Court will not read these limitations in the preferred embodiment into the

27   claims.

28

1   Accordingly, the Court construes the term "content-based cache/query and result cache"

2 to mean: "A store of previous queries and corresponding result sets executed by the system."

3   **4.   "Unified query and result cache/unified query cache"**

4   The terms "unified query and result cache/unified query cache" appear in Claims 1 and

5 18 of the '326 Patent. At the *Markman* hearing, Yahoo! stated they would not pursue

6 construction of any claims with respect to the '326 Patent. Because this term only appears in

7 the '326 Patent, the Court will not construe "unified query and result cache/unified query

8 cache."

9   **5.   "Content source(s)"**

10   The term "content source(s)" appears in Claim 1 of the '326 Patent and Claims 1, 44,

11 and 45 of the '529 Patent.

12   MasterObjects argues that the term "content source(s)" must be construed to mean "A

13 server computer that provides information." (Statement at 3.) Yahoo!, on the other hand,

14 argues that the term must be construed to mean "A server computer that provides data to a third-

15 party application that is capable of performing string-based queries and returning string-

16 formatted answers to the system by accessing its own database or by querying other information

17 systems." (*Id.*)

18   The key dispute between the parties is whether the limitation of a third-party application

19 should be construed in the term. Yahoo! has also proposed additional limitations to the term,

20 namely that a content source is "capable of performing string-based queries."

21   Yahoo!'s proposed definition again comes from the glossary of the '639 Patent. Yahoo!

22 cites to the glossary section:

23   Content Source

24   A server computer that provides the data that is accessed by the QuestObjects
     system. The content source makes its data available through a content engine.
25   For best performance, the content source must be located on the same LAN as
     the QuestObjects Server, and could even be hosted on the very same server
26   computer. The QuestObjects Server can be linked to any number of content
     sources. To retrieve specific information from the content source, one or more
27   content channels are configured on the QuestObjects Server.

28

13

1   ('639 Patent at 10:23-31.) Yahoo! also points to the definition of "Content Engine" in the '639

2   Patent glossary and seeks to import those limitations into its proposed construction. "Content

3   Engine" is defined as "a third-party application that runs on the content source that is capable of

4   performing string-based queries and returning string-formatted answers to the QuestObjects

5   system." (*Id*. at 10:13-15.) Yahoo! argues that one must also look to the glossary definition of

6   "Content Engine" fully to understand the meaning of "Content Source" given the fact that

7   "content engine" is mentioned in the glossary definition of "Content Source."

8   As stated throughout this Order, the Court views the language which Yahoo! relies upon

9   as a preferred embodiment of the invention. *See Phillips*, 415 F.3d at 1323 ("although the

10 specification often describes very specific embodiments of the invention, we have repeatedly

11 warned against confining the claims to those embodiments"); *see also Abbott Laboratories*, 566

12 F. 3d at 1288 ("[w]hen consulting the specification to clarify the meaning of claim terms, courts

13 must take care not to import limitations into the claims from the specification.")

14   Here, the Court finds the glossary defines the QuestObjects embodiment. (*See* '639

15 Patent at 6:18-21 ("In the detailed description below, embodiments of the present invention are

16 described with reference to a particular embodiment named QuestObjects, created by the

17 MasterObjects company.").) Indeed, the first sentence Yahoo! relies upon for their proposed

18 construction reinforces this point. The definition of Content Source in the glossary clearly

19 states the data is being accessed by the QuestObjects system, that is, the preferred embodiment.

20   Accordingly, the Court construes the term "Content Source" to mean: "A server

21 computer that provides the data that is accessed by the system."

22   **6.   "Session/user session"**

23   The terms "session/user session" appear in Claims 1 and 18 of the '326 Patent and

24 Claims 1 and 13 of the '639 Patent.

25   MasterObjects argues that the terms "session/user session" should be construed to mean

26 "A related set of communications between a client and a server as the user enters a particular

27 search query by entering consecutive characters." (Statement at 3-4.) Yahoo!, on the other

28 hand, argues that the term should be construed to mean "A state maintained between a client

14

1   and a single server in which the server recognizes when subsequent requests originate from the

2   same user such that information about the user's past queries is required to process the current

3   request." (*Id.*)

4   There are two key disputes with regard to the term "session." The parties first dispute

5   what actions are taken within a session. Secondly, the parties dispute whether the relationship

6   between the client and the server may include more than one server or if the client is limited to

7   communicating to a single server within a session.

8   Yahoo! makes two arguments regarding their proposed construction of the term

9   "session." Yahoo!'s first argument is premised on the language found in the specification of the

10   '529 and '639 Patents. The language Yahoo! relies upon provides:

11   In accordance with one embodiment of the invention the system is session-based,
         in that the server knows or recognizes when subsequent requests originate at the
12   same Client. Thus, in responding to a character the Server receives from a Client
         it can use the history of data that has been to and from the current user.
13

14   ('639 Patent at 14:12-17; '529 Patent at 12:9-14.) MasterObjects points to the "in accordance

15   with one embodiment . . . " language that Yahoo! relies on and argues that Yahoo! attempts to

16   take a narrow notion specific to one embodiment and read that limitation into the general

17   claims.

18   Here, MasterObjects expressly states that it describes an embodiment and is not

19   specifically defining the claims. The Court cannot find from this language a clear intent by

20   MasterObjects to read these limitations into the claims. *See MySpace*, 672 F.3d at 1255.

21   Accordingly the Court will not take into consideration the language cited from the specification

22   in construing the term "session."

23   The second dispute between the parties is whether the relationship between the client

24   and the server is tied to a single server. MasterObjects argues the plain meaning of the term

25   "session" is set out in Claim 1, which states: " . . . and within a session between the client

26   system and the *server system* . . . ." ('529 Patent at 31:46-32:33 (emphasis added).)

27   MasterObjects contends that the language of Claim 1 refers to a *server system* as opposed to a

28   single server. Additionally, MasterObjects' specification also states that there can be multiple

servers involved in the back end. (*See* '529 Patent at 5:67-6:2 ("A plurality of servers can be

used . . .").) The Court agrees with MasterObjects in that a plurality of servers may be used in

the patent, but the issue is whether a plurality of servers and a client communicate *within a*

session.

Yahoo! cites to examples from the prosecution history in support of their argument that

a "session" is limited to a single server. In reviewing the prosecution history, the scope of

coverage of the claims may change if the court finds the patentee has "relinquished [a] potential

claim construction in an amendment to the claim or in an argument to overcome a reference."

See Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 979 (Fed. Cir. 1999); *see also Southwall*

Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1584 (Fed. Cir. 1995) ("Clear assertions made

during prosecution in support of patentability, whether or not actually required to secure

allowance of the claim, may also create an estoppel."). To invoke argument-based estoppel, the

prosecution history must evince a "clear and unmistakable surrender of subject matter." *Eagle*

Comtronics, Inc. v. Arrow Commc'n Labs., Inc., 305 F.3d 1303, 1316 (Fed. Cir. 2002) (quoting

Pharmacia & Upjohn Co. v. Mylan Pharm., Inc., 170 F.3d 1373, 1377 (Fed. Cir. 1999).

Yahoo! argues that MasterObjects limits a "session" to a single server when

MasterObjects distinguished themselves from the Purcell prior art reference. Yahoo! cites the

patentee's argument for traversing the Purcell prior art rejection:

> [I]n Purcell, the primary goal is to allow a single query from a client to be
> simultaneously applied against multiple databases in a network. The system
> disclosed therein provides that any of the multiple databases that cannot service
> the specific client query return an empty result (indication for example "sorry, I
> can't fulfill that request"). Indeed, it appears more advantageous to have a
> network-wide dispersal of the queries, so as to maximize the chances that at least
> one of the servers can provide the desired data, rather than to have those queries
> contained within a single session between a single client and a single server.
> The system then allows another database in the network that can fulfill the
> request to return the requested data. As such, Applicant respectfully submits that
> Purcell does not disclose a *session-based* environment . . . . Instead, Purcell
> appears to disclose a traditional synchronous means of requesting information,
> and not one that uses a session, as presently defined.

(Smith Decl., Ex. D at 13 (emphasis in original).) Here, MasterObjects appears to distinguish

itself from the prior art by describing how the Purcell system works: dispersing client queries

to multiple servers to maximize the chances that one of the servers can return the data, "rather

1   than to have those queries contained in a single session between a single client and a single

2   server." (*Id.*) Immediately following this distinction, MasterObjects states "a[s] such . . .

3   Purcell does not disclose a *session-based* environment." (*Id.* (emphasis in original).)

4   MasterObjects made the argument that Purcell can be distinguished from its present

5   invention because Purcell is not "session-based" given the use of multiple servers.

6   MasterObjects then states Purcell does not "use a session, as presently defined." (*Id.*) Thus, the

7   Court finds that MasterObjects has clearly and unmistakably disclaimed a multiple-server

8   system during prosecution of its patents.

9   Accordingly, the Court construes the term "session" to mean: "A relationship

10   maintained between a client and a single server in which the server recognizes when

11   consecutive requests originate from the same client."

12   **7.   "Increasingly appropriate content or search criteria" and
                      "Increasingly relevant content"**

13

14   The term "increasingly appropriate content or search criteria" appears in Claim 18 of

15   the '326 Patent and Claims 44 and 45 of the '529 Patent. MasterObjects argues this term should

16   be given its plain meaning. Yahoo!, on the other hand, argues that the term is not amenable to

17   construction and the claims containing them are invalid as indefinite.

18   The term "increasingly relevant content" appears in Claims 1 and 18 of the '326 Patent

19   and Claims 1 and 13 of the '639 Patent. MasterObjects argues this term should be given its

20   plain meaning. Yahoo!, on the other hand, argues that the term is not amenable to construction

21   and the claims containing them are invalid as indefinite.

22   At the *Markman* hearing, MasterObjects argued that the Court should not address the

23   question of indefiniteness until the parties have been able to conduct expert testimony.

24   Alternatively, Yahoo! argued that even with expert testimony the terms in dispute would still be

25   indefinite because they are ordinary words that do not have any particular meaning.

26   "In determining whether the claim is sufficiently definite, we must analyze whether 'one

27   skilled in the art would understand the bounds of the claim when read in light of the

28   specification.'" *Allen Eng. Corp. v. Bartell Indus. Inc.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002)

United States District Court

For the Northern District of California

1 (quoting *Personalized Media Communications, LLC. v. Int'l Trade Comm'n*, 191 F.3d 696, 705

2 (Fed. Cir. 1998)). Claims that are "'not amenable to construction or [are] insolubly ambiguous

3 are indefinite." *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1371 (Fed.

4 Cir. 2008) (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir.

5 2005)). "Because a patent is presumed to be valid," the "evidentiary burden to show facts

6 supporting a conclusion of invalidity is one of clear and convincing evidence." *Automotive*

7 *Tech. Int'l Inc. v. BMW of North Am., Inc.*, 501 F.3d 1274, 1281 (Fed. Cir. 2007) (citing *AK*

8 *Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1238-39 (Fed. Cir. 2003)).

9   Second, rather than giving meaning to a claim, as a *Markman* hearing is meant to do,

10 indefiniteness invalidates the patent claims entirely. *Exxon Research & Eng'g Co. v. United*

11 *States,* 265 F.3d 1371, 1376 (Fed. Cir. 2001). This dispositive effect is more appropriately

12 tackled at summary judgment. Thus, this Court finds persuasive the determinations of several

13 other courts to defer indefiniteness until summary judgment. *See, e.g., Intergraph Hardware*

14 *Techs. Co. v. Toshiba Corp.,* 508 F. Supp. 2d 752, 773 n.3 (N.D. Cal. 2007) ("[The]

15 indefiniteness argument is inappropriate at the claim construction stage."); *Pharmastem*

16 *Therapeutics, Inc. v. Viacell, Inc.,* 2003 WL 124149, at *1 n.1 (D. Del. Jan. 13, 2003) ("[T]he

17 court will not address the defendants' indefiniteness argument at [the *Markman* stage].").

18 Indeed, the Federal Circuit in *Halliburton, Exxon,* and *Datamize* reviewed courts that dismissed

19 the case for indefiniteness at summary judgment, not at a prior *Markman* hearing. *Halliburton,*

20 514 F.3d at 1249; *Exxon,* 265 F.3d at 1373; *Datamize, LLC v. Plumtree Software, Inc.,* 417 F.3d

21 1342, 1347 (Fed. Cir. 2005).

22   Accordingly, the Court holds that the claims are sufficiently definite to survive claim

23 construction and will defer the indefiniteness argument until a more appropriate time.

24 <div align="center">**CONCLUSION**</div>

25   Based on the analysis set forth above, the Court adopts the foregoing constructions of

26 the disputed terms. The parties are ordered to submit a further joint case management report

27 pursuant to Patent Standing Order ¶ 13 by no later than February 7, 2014. The Court shall hold

28 ///

United States District Court

For the Northern District of California

18

a case management conference in this consolidated matter on February 21, 2014 at 1:30 p.m.

IT IS SO ORDERED.

Dated: November 26, 2013

JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE